

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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1761

In re Application of
Vivian A. Schramm
Michael R. Schramm

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Group Art Unit: 1761

Serial No.: 09/707,156

Examiner: Steven L.
Weinstein

Filed: November 06, 2000

For: Spill-Proof Candy Container

APPEAL BRIEF

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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Michael R. Schramm	August 9, 2004
Applicant	Date
<i>Michael R. Schramm</i>	<i>Michael R. Schramm</i>
Signature	

Dear Sir:

Pursuant to 37 C.F.R. 1.192, Appellants submit this Appeal Brief in triplicate to the Board of Patent Appeals and Interferences in support of their appeal from the decision dated September 29, 2003 of the Examiner rejecting claims 1-14 and 21-25 of the captioned application and in response the official office action dated May 21, 2004. Applicants submit herewith a late fee in the amount of \$210 for a small entity pursuant to 37 CFR § 1.17(a) via a credit card payment using attached form PTO-2038 for responding two months late to said office action. Appellants note that an appeal brief fee of \$165 was submitted with Appellants original brief on February 24, 2004. Appellants submit that the Examiner erred in rejecting the claims, and respectfully requests reversal of the rejection. Appellants also submit that the appeal brief submitted on February 24, 2004 complied with the requirements of 37 CFR § 1.192(c) inasmuch as the appeal brief of February 24, 2004 satisfied all of the requirements of 37 CFR § 1.192(c), but also specifically included a concise explanation of the invention defined in the claims involved in the appeal and that such explanation referred to the specification by page and line number and to the drawing figures by reference characters. Nevertheless, Appellants have revise this brief to more explicitly comply with 37 CFR § 1.192(c).

(1) **Real Party in Interest**

The real party in interest is Vivian A. Schramm and Michael R. Schramm.

(2) **Related Appeals and Interferences**

Appellants are unaware of any pending appeal or interference which affects this appeal.

(3) **Status of Claims**

Claims 1-14 and 21-25 are pending and on appeal. Claims 15-20 have been cancelled.

(4) **Status of Amendments**

The appealed claims have been finally rejected. There has been no amendment filed subsequent to the final rejection of the claims.

(5) **Summary of Invention**

The present invention is a self-contained spill-resistant container of an edible particulate matter having a lollipop type candy which is removably contained within the container as identified by feature number 10 in drawing figures 1 through 3 and as summarized in the specification on page 4 lines 13 through 24. The invention has particular application for ease of use by young children in consuming particulate candy combined with a lollipop type candy without the normal mess and spills typically associated with the consumption of such candy by children.

(6) **Issues**

The issues on appeal are 1) whether or not claims 21 and 23-25 are non-enabling due to containing new matter under 35 USC § 112, first paragraph, and 2) whether or not the examiner has properly rejected the appealed claims based on obviousness under 35 USC § 103(a) over Hunter (GB '356) and Matindale ('797) in view of Coleman ('884) and Hoeting et al ('870) or vice versa.

(7) Grouping of Claims

The groups of claims 1-7, 8-14, and 21-25 should be separately considered. Claims 1-7 stand or fall together, claims 8-14 stand or fall together, and claims 21-25 stand or fall together. The three groups of claims do not stand or fall together.

(8.1) Argument 1, Claims 21 and 23-25 were erroneously rejected as non-enabling due to new matter:

Appellants respectfully point out that the group of claims 21 and 23-25 are separately patentable from the groups of claims 1-7 or 8-14 due to the different subject matter claimed in each group of claims. Specifically, the claims of group 1-7 are drawn to a container of having a predetermined shape and containing predetermined contents. Whereas the claims of group 8-14 are drawn to a container of having not only a predetermined shape and containing predetermined contents, but also being limited to being spill resistant. Further, the claims of group 21 and 23-25 are drawn to a container of having not only a predetermined shape, but also being limited to containing an edible fluent non-gaseous substance and a solid confectionery material. Due to these substantial patentably distinct limitations, each group of claims is seen as being separately patentable and each group of claims is seen as standing or falling separately.

Appellants respectfully traverse the Examiners argument that Appellant's application contains new matter. The examiner argues that the use of the phrase "edible fluent non-gaseous material" constitutes new matter and further that "the specification only recites that the substances to be placed in a container are edible particulate candy material". Appellants respectfully point out the original specification specifically stated, "Edible particulate matter 60 defines a free flowing edible particulate matter such as flavored candy powder, candy beads, or any other particulate type edible material" (see page 6, first paragraph, last sentence).

The following is a quotation of 35 USC § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The appellants respectfully maintain that inasmuch as a “free flowing edible particulate matter such as flavored candy powder” was disclosed in the original specification, with respect to an “edible fluent non-gaseous material”, the written description requirement of 35 USC § 112, first paragraph is satisfied. Thus even though an “edible fluent non-gaseous material” may read on a liquid, such reading on a liquid does not negate the satisfaction of 35 USC § 112, first paragraph’s written description requirement. If on the other hand, the applicant’s had claimed matter that was not supported in the original specification, such as for instance by “adding specific percentages or compounds after a broader original disclosure” or by “the omission of a step from a method”, the applicant’s would agree that new matter was added.

Thus by reading 35 USC § 112, first paragraph, the appellants urge that the test to determine new matter is not “Can the claims read on matter not disclosed in the specification?” as the examiner implies but rather “Are the claims supported by the original specification?”. The appellants argue that if the appellant’s original specification can support the phrase in question, then the claimed subject matter cannot be construed to be new matter. The appellants offer the following comparison as an example in support of their position. If for instance an applicant disclosed an automotive vehicle having red colored tires, ignoring any issues of novelty and obviousness, etc., the appellants argue that the applicant should be entitled to claim “a vehicle having non-black colored tires”. Conversely, by the reasoning established in the examiner’s rejection, the applicant would not be able to make the noted claim as “a vehicle having non-black colored tires” would read on a vehicle having blue (or other non-black) colored tires when only red colored tires were disclosed. Again, the applicant’s disagree with the latter argument.

Accordingly, the appellants suggest that a closer analysis of the phrase in question with respect to the specification will reveal that the original specification does in fact support the phrase in question. An analysis is as follows. It will be readily understood that the original specification taught a container that contained edible particulate matter (see for instance the original specification page 4, SUMMARY OF THE INVENTION, 1st sentence). It was further taught how the container resisted spills of the contained substance regardless of the orientation of the container. The specification made it clear that in order to achieve the described spill resistance per the described method, that the contained matter needed to exhibit the property of flow or in other words, the matter needed to be fluent. It will also be

understood that particulate matter is neither a gas nor a gaseous substance. It follows then that even though an “edible fluent non-gaseous material” may read on a liquid, an “edible fluent (i.e. exhibiting a property of flow) non-gaseous (i.e. a particulate) material” is in fact supported by the original specification. In as much as it is established that the original specification supports the claimed subject matter, it is urged that a “new matter” rejection is not proper and it is requested that the rejection be reversed.

(8.2) Argument 2, Claims 1 -7 were erroneously rejected as obvious:

The examiner has rejected claims 1-7 under 35 USC § 103(a) based on the combination of Hunter (GB ‘356)/Martindale (‘797) and Coleman (‘884)/Hoeting et al (‘870). The appellants respectfully traverse the examiner’s rejection on the basis of both negative teachings and closely related commercial success.

Negative Teaching: As noted in the appellant’s last office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise,

because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve the their own recognized problem of spill resistance of accessible particulate candy. The appellants suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

Commercial Success: The appellants respectfully suggest that the examination of the subject patent application is nearly identical to the examination of the patent application of which the subject application is a continuation. Specifically in examining the 5,246,046/RE36,131 application, bubble solution containers having some form of a funnel and/or spill resistance such as 2858,639, 3,579,898, 3,818,627, 4,840,597, and 5,088,950 and containers for liquid having funnels such as 676,924, 1,210,397, 5,022,559, and 5,105,975 were cited. However, in spite of such combined bubble solution container art and such funneled container art, the '046/RE36,131 examiner did not declare the invention to be obvious. Time has since vindicated this examiner's position. In 1993, approximately one year after the '046 application was filed, a product incorporating the technology disclosed in the '046 application was introduced to the market by the Little Kids corporation of Providence, Rhode Island. Many other similar products made by many other companies also using the technology disclosed in '046 soon followed. In 1995, one of the current applicants, Michael R. Schramm, licensed the '046 patent to the Strombecker corporation of Chicago, Illinois. Subsequent to the Strombecker license agreement, Schramm also sublicensed Little Kids, inc., Imperial Toy, Inc., Toys R Us, inc., and Placo, Inc. In the decade since the first spill resistant bubble solution container incorporating '046 technology was introduced to the market, the product in it's many different embodiments, has gone on to generate multiple millions of dollars worth of retail sales. Various versions of the container continue to be available in every state of the union in stores such as Wal Mart, K Mart, and Toys R Us.

The appellants suggest that the spill resistant candy container is no more obvious than was the spill resistant bubble solution when the spill resistant bubble solution container application was originally filed.

In conclusion, the appellants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers. Given both the negative teaching and the related commercial success, it is urged that an “obvious” rejection is not proper and it is requested that the rejection be reversed.

(8.3) Argument 3, Claims 8 -14 were erroneously rejected as obvious:

The examiner has rejected claims 8-14 under 35 USC § 103(a) based on the combination of Hunter (GB ‘356)/Martindale (‘797) and Coleman (‘884)/Hoeting et al (‘870). The appellants respectfully traverse the examiner’s rejection on the basis of both negative teachings and closely related commercial success.

Negative Teaching: As noted in the appellant’s last office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of

coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve the their own recognized problem of spill resistance of accessible particulate candy. The appellants suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

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to generate multiple millions of dollars worth of retail sales. Various versions of the container continue to be available in every state of the union in stores such as Wal Mart, K Mart, and Toys R Us. The appellants suggest that the spill resistant candy container is no more obvious than was the spill resistant bubble solution when the spill resistant bubble solution container application was originally filed.

In conclusion, the appellants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers. Given both the negative teaching and the related commercial success, it is urged that an “obvious” rejection is not proper and it is requested that the rejection be reversed.

(8.4) Argument 4, Claims 21 -25 were erroneously rejected as obvious:

The examiner has rejected claims 21-25 under 35 USC § 103(a) based on the combination of Hunter (GB ‘356)/Martindale (‘797) and Coleman (‘884)/Hoeting et al (‘870). The appellants respectfully traverse the examiner’s rejection on the basis of both negative teachings and closely related commercial success.

Negative Teaching: As noted in the appellant’s last office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers

lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve the their own recognized problem of spill resistance of accessible particulate candy. The appellants suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

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In conclusion, the appellants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers. Given both the negative teaching and the related commercial success, it is urged that an "obvious" rejection is not proper and it is requested that the rejection be reversed.

(9) **Appendix**

The following are the claims involved with this appeal.

1. A container defining an inner cavity and a funnel extending into said inner cavity, wherein said container contains a substance of one of the following group of substances comprising a non-liquid edible substance, an edible particulate substance and a candy substance.
2. The container of claim 1 wherein said non-liquid edible substance further defines a substance of one of the following group of substances comprising a particulate substance, a candy powder substance, a candy bead substance, a substantially hard candy substance, a lollipop type candy substance, a particulate substance and a solid form substance, a candy powder substance and a substantially hard candy substance, a particulate substance and a lollipop type candy substance, and a candy powder substance and lollipop type candy substance and wherein said edible particulate substance further defines a substance of one of the following group of substances comprising an edible powder substance, a candy powder substance, and a candy bead substance.
3. The container of claim 1 wherein said container inhibits the spillage of said substance when said container is oriented in any position.
4. The container of claim 3 wherein said container includes a lollipop type candy within said container and wherein said lollipop type candy is removable from said container by passing said lollipop type candy through said funnel.
5. The container of claim 1 wherein said substance defines a lollipop type candy having a handle and wherein said handle includes a pliable holder mounted to said handle and wherein said holder is sealingly engagable to said container.
6. The container of claim 1 wherein said funnel includes an inner opening and wherein said inner opening is located near the center of said container.
7. The container of claim 1 wherein at least a portion of said container is substantially transparent so as to reveal the contents of said container.

8. A container defining an inner cavity and an open opening and wherein said container contains a substance and wherein said container inhibits the spillage of said substance when said container is oriented in any position and wherein said substance defines a substance of one of the following group of substances comprising a non-liquid edible substance, an edible particulate substance and a candy substance.
9. The container of claim 8 wherein said non-liquid edible substance further defines a substance of one of the following group of substances comprising a particulate substance, a candy powder substance, a candy bead substance, a substantially hard candy substance, a lollipop type candy substance, a particulate substance and a solid form substance, a candy powder substance and a substantially hard candy substance, a particulate substance and a lollipop type candy substance, and a candy powder substance and lollipop type candy substance and wherein said edible particulate substance further defines a substance of one of the following group of substances comprising an edible powder substance, a candy powder substance, and a candy bead substance.
11. The container of claim 10 wherein said container includes a lollipop type candy within said container and wherein said lollipop type candy is removable from said container by passing said lollipop type candy through said funnel.
12. The container of claim 8 wherein said substance defines a lollipop type candy having a handle and wherein said handle includes a pliable holder mounted to said handle and wherein said holder is sealingly engagable to said container.
13. The container of claim 10 wherein said funnel includes an inner opening and wherein said inner opening is located near the center of said container.
14. The container of claim 8 wherein at least a portion of said container is substantially transparent so as to reveal the contents of said container.

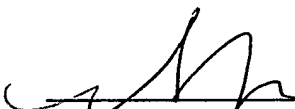
21. A container defining an inner cavity and a funnel extending into said inner cavity, wherein said container contains an edible fluent non-gaseous substance and wherein said container at least partially contains a removable unit of substantially solid confectionery material.
22. The container of claim 21 wherein said fluent non-gaseous substance further defines a substance of one of the following group of substances comprising a particulate substance, a granular substance, a powder substance, a candy powder substance, a candy bead substance.
23. The container of claim 21 wherein said container inhibits the spillage of said substance when said container is oriented in any position.
24. The container of claim 21 wherein said funnel includes an inner opening and wherein said inner opening is located near the center of said container.
25. The container of claim 21 wherein said unit of substantially solid confectionery material further defines a lollipop having a substantially solid edible candy portion and a handle portion.

(10) Conclusion

In view of the comments above, it is submitted the Examiner erred in rejecting the claims on appeal. Appellants therefore respectfully request that this Honorable Board reverse the Examiner's rejection of the claims. If the Board has any questions or comments which may be resolved over the telephone, the board is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: August 9, 2004

Respectfully submitted,


Vivian A. Schramm


Michael R. Schramm

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